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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,783	12/30/1999	DONALD K. NEWELL	1020.P6929	2707

57035 7590 07/18/2007

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EXAMINER	
SHANG, ANNAN Q	

ART UNIT	PAPER NUMBER
2623	

MAIL DATE	DELIVERY MODE
07/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/474,783	NEWELL ET AL.	
	Examiner	Art Unit	
	Annan Q. Shang	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 April 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-7 and 12-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-7 and 12-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 4-7 and 12-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gotwald (5,987,518)** in view of **Horton et al (4,945,563)** and further in view of **Russo (5,619,247).**

With respect to Claims 1 and 4-6, **Gotwald** teaches a system for controlling use of broadcast content (BC) comprising:

A receiver (Client 18) in communications with a source of broadcast content (Server 12) and a playback device and a storage device, the receiver comprising a data interface having an Internet Protocol (IP) data module to process a pay-per-use IP TV broadcast stream comprising IP encapsulated data, the receiver to control the use of received BC through the playback device and the storage device in accordance with a descriptor embedded in the received BC (col.3, line 26-col.4, line 32 and line 55-col.5, line 41).

Gotwald permits the Client to purchased various services and provides security to data by encrypting the data, but silent to a descriptor to indicate whether the storage device may store the received BC prior to viewing and without reproducing the received

BC, storing the broadcast content and a number of times the playback device may reproduce the received broadcast content.

However, **Horton** teaches broadcasting audiovisual content along with embedded descriptor information to define an action to be taken pertaining to the received content, explicitly storing the received broadcast content (col.3 lines 38-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention to modify Gotwald with the ability to specify the action as storing the content and embedding descriptor information in order for the broadcast provider to specify what could be done to the broadcast programs to prevent unauthorized copying and also allow the user to only access certain programs.

Gotwald as modified by Horton, fails to explicitly teach controlling the number of times that the BC may reproduce the stored BC, maintaining information relating to the use or duration of use of the received BC through the playback device for remuneration of a provider of the BC.

However, **Russo** further teaches a descriptor or supplemental information with the BC, where a receiver-controller, manages playbacks of stored BC, including duration (time, days, week, etc.,) of use, monitors various user activities as to the use of the BC, controlling billing and payment for remuneration of a provider of the BC (col.4 line 45-col.5 line 47, col.6 lines 34-55, col.8 lines 65-67 and col.9 line 1+).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention to incorporate the teaching of Russo into the system of Gotwald as modified by Horton to manage the reproduction of the stored BC for fees and royalties

to the service provider and furthermore, permit only authorized user, based on credit or payment history, to reproduce and view the stored BC any number of times as desire.

As to claim 7, the claimed "method comprising..." is composed of the same structural elements that were discussed in the rejection of claims 1 and 4-6.

Claims 12-15 are met as previously discussed with respect to claims 1 and 4-6.

As to claims 16-18, Gotwald further discloses obtaining payment information from the user of the received broadcast content, communicating consumption information to a billing facility at the service provider of the BC (col.4, line 49-col.5, line 6).

As to claim 19, the claimed "a machine-readable medium... a method comprising..." is composed of the same structural elements that were discussed in the rejection of claims 1 and 4-6.

As to claim 20, Gotwald further discloses where the storage comprises a memory accessible by a computer (col.3, line 51-col.4, line 7).

As to claim 21, Gotwald as modified by Horton and Russo, fail to show that the storage medium comprises a portable storage device. However, Official Notice is taken that it is well known and expected in the art to use removable storage devices, such as CD-ROMS or removable hard drives.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention to modify the system of Gotwald as modified by Horton and Russo with a portable storage device so that the instructions could be transported to other systems.

As to claims 22-25, the claimed "A system comprising a receiver in communication with a source of broadcast content..." is composed of the same structural elements that were discussed in the rejection of claims 1 and 4-6.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 4-7 and 12-25 have been considered but are moot in view of the new ground(s) of rejection, i.e., **Gotwald (5,987,518)** in view of **Horton et al (4,945,563)** and further in view of **Russo (5,619,247).**

With respect to claims 1, 4-7, 9 and 12-25 rejected under 35 U.S.C. 103(a) as being unpatentable over **Russo (5,619,247)** in view of **Horton et al (4,945,563)** and further in view of **Gotwald (5,987,518),** applicant amends claims, cites MPEP as to obviousness and argues that the prior art of records do not teach the amended claim limitations (see page 7+ of Applicant's Remarks).

In response, Examiner disagrees, as discussed in the above office action **Gotwald (5,987,518)** in view of **Horton et al (4,945,563)** and further in view of **Russo (5,619,247),** meet the amended claims limitations. As to applicant's argues regarding obviousness, Examiner notes applicant's arguments, however, Examiner maintains that, the test for obviousness is not whether the features of a secondary reference may be bodily incorporate into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all the references. Rather, the test is what the combined teachings of the references would have suggested to those of

ordinary skill in the art. In this case all reference are in the same field of endeavor, i.e., a TV receiver, which receives and processes TV signals. Furthermore it appears Applicant's arguments are directed against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Hence, Examiner has replied the references, **Gotwald (5,987,518)** in view of **Horton et al (4,945,563)** and further in view of **Russo (5,619,247),** to meet the amended claims limitations. Note that Gotwald teaches processing IP television broadcast comprising IP encapsulated data including encrypting the data to provide security and permits the customer to purchase various level of services for a fee (col.3, line 51-col.4, line 38 and line 49-col5, line 41), as discussed above in the office action. Furthermore, Horton teaches the claimed "a descriptor embedded in the received broadcast content, the descriptor to indicate whether the storage device may store the received broadcast content prior to viewing and without reproducing..." and Russo teaches managing the number of times the stored BC is reproduced. The amendment to the claims necessitated the new ground(s) of rejection discussed above. **This office action is made final**.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Saito et al (6,751,221) disclose data transmitting node and network inter-connection node suitable for home network environment.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone

number for the organization where this application or proceeding is assigned is **571-273-8300.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC) at 866-217-9197 (toll-free).** If you would like assistance from a **USPTO Customer Service Representative or access** to the automated information system, **call 800-786-9199 (IN USA OR CANADA) or 571-272-1000**.

Annan Q. Shang